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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,345	07/28/2003	Philip S. Green	00287S-004450US	6351

20350 7590 06/21/2005

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EXAMINER

ROBERT, EDUARDO C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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10/629,345

EXAMINER

E. Robert

ART UNIT	PAPER
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3732

20050611

DATE MAILED:

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Commissioner for Patents

The reply filed on March 18, 2005 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

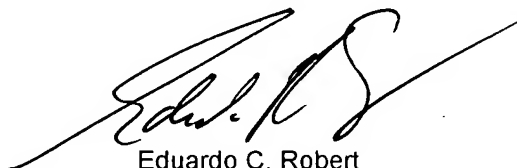
Newly submitted claims 24-43 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: canceled claims 13-23, originally presented, (Group 1) were directed to a surgical instrument manipulator system classify on 606/130; new claims 24-37 (Group 2) are directed to a surgical instrument classify on 606/205; and new claims 38-43 (Group 3) are directed to a surgical instrument classify on 606/1. If these groups were have been presented together, they would have been restricted as follow Group 1 and Group 2 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a surgical instrument with a bendable, steerable distal portion. The subcombination has separate utility such as a forceps. Group 1 and Group 3 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a surgical instrument with a bendable, steerable distal portion. The subcombination has separate utility such as a robotic arm forceps. Group 3 and Group 2 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a surgical instrument including a second end of a linkage releasably coupleable to a robotic manipulator assembly. The subcombination has separate utility such as a forceps. Also, these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, these inventions are distinct for the reasons given above and the whole search required for Group 2 and 3 is not required for Group 1, restriction for examination would have been proper.

Now, since the claims of Group 1 were elected by original presentation and received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, new claims 24-43 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Thus, since claims 24-34 are withdrawn from consideration, for the reasons set forth above, and claims 13-23 were canceled by applicant in the response of March 18, 2005 where the new claims were included, the application does not have any claim directed to the invention elected by original presentation and thus the response filed on March 18, 2005 is considered non-responsive.

See 37 CFR 1.111. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571-273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert
Primary Examiner
Art Unit: 3732